

REMARKS

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks, as well as the amendments and remarks set forth in the Amendment and Response to Final Rejection filed February 19, 2009.

Specification Amendments

The Abstract has been amended to correct a typographical error, and to replace “aluminoxane part” with “trimethylaluminum”, as was previously done in the specification and claims. This amendment is discussed in detail below. No new matter has been added to the application by these amendments.

Potential Issue Under 35 U.S.C. § 112, First Paragraph

The Examiner issued an Office Action on April 29, 2009, which was later vacated due to the Suspension of Action Under 37 C.F.R. § 1.103(c), filed April 20, 2009. In this vacated Office Action, the Examiner rejected claim 1 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Specifically, the Examiner indicated that in (ii) of claim 1, the limitation “a mole fraction of methyl groups originating from trimethylaluminum” is new matter. The Examiner stated that the application as originally filed only supports the limitation “a mole fraction of methyl groups originating from aluminoxane part”.

It is not required that Applicants respond to this rejection, since the Office Action in which the rejection was presented has been vacated. However, in order to expedite allowance of the application, Applicants wish to address this rejection now.

Applicants note that the amendment to which the Examiner refers was presented in a Preliminary Amendment filed September 20, 2006. As indicated in the remarks attached to the Preliminary Amendment, the claims were amended in this manner in order to be consistent with the Amendment filed under PCT Article 34 during the International Phase.

The amendment changing “aluminoxane part” to trimethylaluminum” was made in the PCT application, as well as in the present application, because it is the amount of

trimethylaluminum, not the amount of aluminoxane part, which is determined in the Examples of the specification.

Specifically, Applicants direct the Examiner's attention to Example 1 of the specification, which states, "Me(TMAL) amount of the resultant polymethylaluminoxane preparation . . . was 21.4 mol%." (Emphasis added.) It is clear from this passage, as well as the similar passages in each of the Examples, that it is the amount of trimethylaluminum, rather than the amount of aluminoxane part, which is determined. Additionally, Examples 1-5 disclose Me(TMAL) values of 15.5mol% to 22.6mol%, which clearly fall within Applicants' recited range of "not more than 26 mol%".

Accordingly, the amendment is fully supported by Applicants' originally filed specification. Thus, there is no basis for a rejection under 35 U.S.C. § 112, first paragraph for failing to comply with the written description paragraph.

Further Remarks

Applicants respectfully request that the Examiner consider the detailed arguments set forth on pages 5-7 of the Amendment and Response to Final Rejection, filed February 19, 2009.

As noted in the last sentence of the second paragraph on page 3 of the Final Rejection, the Examiner takes the position that one would have expected the viscosity of the examples of Smith et al. (U.S. Patent No. 5,831,109) to inherently meet the limitation of the instant claims. Further, the Examiner asserts that even if the claimed viscosities are not inherent in the PMAO composition of the prior art examples, it would still have been obvious to a skilled artisan to prepare PMAO compositions with lower viscosities, to prevent gel formation. Lastly, the Examiner indicates that once a product appearing to be substantially identical is found, and a 35 U.S.C. § 102/103 rejection is made, the burden of proof is shifted to Applicants to show an unobvious difference.

Further to the remarks set forth in the response filed February 19, 2009, Applicants enclose herewith a Declaration Under 37 C.F.R. § 1.132 by Dr. Eiichi Kaji, a co-inventor of the above-identified application. The Declaration describes that experiments were conducted according to examples 2 and 4 of Smith et al., in order to confirm the actual results of these

examples.

As discussed on the last page of the Declaration, although Smith et al. disclose PMAO obtained according to examples 2 and 4 showed a high stability, Applicants have now confirmed that examples 2 and 4 of the cited reference actually have an extremely low stability of PMAO.

Accordingly, it is respectfully requested that the rejection set forth in the final rejection of August 19, 2008 be withdrawn.

Conclusion

Therefore, in view of the foregoing amendments and remarks set forth herein, as well as the amendments and remarks set forth in the response filed February 19, 2009, it is respectfully submitted that each of the grounds of rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

If, after reviewing this Amendment, the Examiner feels there are any issues remaining which must be resolved before the application can be passed to issue, the Examiner is respectfully requested to contact the undersigned by telephone in order to resolve such issues.

Respectfully submitted,

Eiichi KAJI et al.

/Amy E. Schmid/

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Amy E. Schmid
Registration No. 55,965
Attorney for Applicants

AES/emj
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250
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Attachments: Clean Copy of Abstract
Declaration Under 37 C.F.R. § 1.132